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**PATENT APPLICATION**



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re reissue application of U.S. Patent 5,924,398  
MICHAEL CHOI

Issued: July 20, 1999

Reissue Appln. 09/909,430

Filed: July 19, 2001

Examiner: HUYNH, HAI H  
Group Art Unit: 3747

Original Patent Application Filing Date: October 6, 1997

For: **FLOW IMPROVEMENT VANES IN THE INTAKE SYSTEM OF AN INTERNAL COMBUSTION ENGINE**

Attorney Docket No.: FMC 1305 R

**RECEIVED**

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**PETITION UNDER 37 C.F.R. §1.183**

Box Reissue  
Commissioner for Patents  
Washington, D.C. 20231

Sir:

Pursuant to 37 C.F.R. §1.183, Applicant respectfully requests that the Commissioner suspend or waive the requirements of 37 C.F.R. §1.78(a)(3), which requires submission of a petition accompanying a reference to an earlier-filed benefit application under 35 U.S.C. §120, if the reference identifying the prior-filed application is submitted more than four months after the filing date of the later-filed application, and further requires the payment of a surcharge under 37 C.F.R. §1.17(t).

Adjustment date: 05/06/2003 EXHLDK  
09/20/2002 HUUONG1 00000033 061510 09909430  
02 FC:122 130.00 CR

Applicant submits that the present reissue application, which was filed on July 19, 2001, presents an extraordinary situation, and that justice requires that §1.78(a)(3) be suspended or waived.

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02 FC:122 130.00 CH

The basis of this petition is that the amendment of 37 C.F.R. §1.78(a)(2)(ii), which first established the four-month period for presenting a reference to an earlier-filed benefit application, was not made until **December 28, 2001**. Under the terms of the amended rule, it was necessary for Applicant to present a reference to an earlier-filed application by **November 19, 2001**, a date which was more than one month **prior** to adoption of the four-month requirement.

It is respectfully submitted that this retroactive application of 37 C.F.R. §1.78(a)(2)(ii) is manifestly unjust, because Applicant could not have been aware of the existence of a four-month time period until after the rule became effective, and until after the period had expired.

For this reason, Applicant respectfully requests that the requirement for a petition to accept an unintentionally delayed claim under 35 U.S.C. §120 for the benefit of a prior-filed application, as set forth in 37 C.F.R. §1.78(a)(3), and the requirement of a surcharge for such petition under 37 C.F.R. §1.17(t), be waived in the present application.

#### **I. REFERENCE TO EARLIER APPLICATIONS IN THE ORIGINAL PATENT**

As issued on July 20, 1999, original U.S. Patent 5,924,398 identified two prior United States patent applications, of which benefit under 35 U.S.C. §120 is claimed, by application serial number and filing date, in the specification at col. 1, lines 5-6, as follows:

This application is related to co-pending application Ser. Nos. 08/847,083 and 08/847,084 filed May 1, 1997.

As required by 35 U.S.C. §120, the original patent thus contained a specific reference to both earlier filed applications.

U.S. Patent Application Ser. No. 08/847,083 issued as U.S. Patent 5,722,357 and U.S. Patent Application Ser. No. 08/847,084 issued as U.S. Patent 5,758,614.

## **II. AMENDMENT TO THE SPECIFICATION IN THE PRESENT APPLICATION**

Applicant filed the present application for reissue of U.S. Patent 5,924,398 on July 19, 2001, to correct an error by reason of the patentee claiming less than he had a right to claim in the patent.

During prosecution of the reissue application, on December 12, 2001, Applicant filed a Preliminary Amendment clarifying the relationship of U.S. Patent 5,924,398 to the two earlier applications cross-referenced in the original patent, to state as follows:

This application is a continuation-in-part of co-pending application Ser. No. 08/847,083 filed May 1, 1997, now U.S. Patent No. 5,722,357 and Ser. No. 08/847,084 filed May 1, 1997, now U.S. Patent 5,758,614.

In an Office Action dated April 18, 2002, the Examiner acknowledged a claim for domestic priority under 35 U.S.C. §120, by checking Box 15 in the Office Action summary.

Applicant considers that the claim to benefit of each prior filed application was stated by the references to earlier filed applications made in the original patent, and that the amendment to the specification made during the present reissue application on December 12, 2001, was merely of a clarifying nature, and was not required to state a claim to benefit of the earlier applications under 35 U.S.C. §120.

## **III. REASON FOR THE PRESENT PETITION**

Because the Examiner has now acknowledged a claim for domestic priority under §120, responsive to the amendment filed on **December 12, 2001**, Applicant wishes to ensure that the application is in formal compliance with the requirements of 37 C.F.R. §1.78, as amended on **December 28, 2001**, 66 Fed. Reg. 67,087.

By its terms, amended §1.78(a)(2)(ii) requires that a reference to a prior-filed application must be submitted in an application filed under 35 U.S.C. §111(a) within the

later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed application. Under §1.78(a)(2)(ii)(A), the four-month time period does not apply if the later-filed application is an application filed under 35 U.S.C. §111(a) before November 29, 2000. If a reference required by 35 U.S.C. §120 and 37 C.F.R. §1.78(a)(2) is presented after the four-month time period, the claim for benefit may be accepted if the reference was unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. §120 and a surcharge are required by 37 C.F.R. §1.78(a)(3).

As amended on **December 28, 2001**, the rule retroactively applies to the present application for reissue of U.S. Patent 5,924,398, which was filed on **July 19, 2001**. Under the amended rule, the four-month period for presenting a reference to a prior-filed application expired on **November 19, 2001**, even though the rule was not adopted until more than a month later.

In the present application, the entire period of delay between the date the claim was due under 37 C.F.R. §1.78(a)(2)(ii), *i.e.*, **November 19, 2001**, and the date that the clarifying amendment concerning the claim to benefit was filed on **December 12, 2001**, was unintentional. It is evident that any delay in filing the clarifying amendment was unintentional, because Applicant could not have been aware of the existence of the four-month time period until the rule was amended on **December 28, 2001**.

As stated above, Applicant considers that the claim to benefit of each earlier filed nonprovisional United States application was established by the identification of the earlier applications in the original patent.

However, to ensure that the present reissue application is in formal compliance with 37 C.F.R. §1.78, as amended on December 28, 2001, Applicant respectfully requests waiver of the requirement for a petition under 37 C.F.R. §1.78(a)(3) and the requirement of payment of a surcharge under 37 C.F.R. §1.17(t), with respect to the claim for benefit stated in the previously-submitted amendment dated December 12, 2001.

An additional fee of \$130.00 is believed to be due for the entry and consideration of the present petition under 37 C.F.R. §1.17(h). The Commissioner is hereby authorized to charge this fee and any other fees or credits in connection with the present Petition to Deposit Account 06-1510 (Ford Global Technologies, Inc.).

Respectfully submitted,



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Date: 8/24/02

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